

REMARKS

Applicant thanks the Examiner for the careful consideration of the application, and offers the following remarks:

35 U.S.C. §101

Claims 8-11 stand rejected under §101 as directed to non-statutory subject matter. Applicant respectfully traverses the rejections.

As to claims 8 and 9, Applicant has amended these claims to better express the nature of the invention. Specifically, amended claim 8 recites a “computer-implemented network reconfiguration program.” The claim further recites that the program causes the computer to execute method steps (i) through (iv). As amended, the claim recites a physical “thing” in that a computer-implemented program is, by definition, capable of being executed. Further, the claim also recites the necessary structural and functional interrelationship described by the Examiner in that the program causes the computer to execute the method steps. Amended claim 9 is grammatically similar to claim 8 and is similarly statutory.

As to claims 10 and 11, Applicant respectfully traverses the Examiner’s characterization of these claims as non-statutory, and responds that the claims as originally submitted conform with the requirements of §101. For example, claim 10 recites a “computer-readable recording medium storing a network reconfiguration program for causing a computer to execute a network reconfiguration method...” The Examiner admits that a computer readable medium encoded with a computer program is statutory. Applicant asserts that there is not a functional difference between an “encoded” program and a “stored” program in that the act of storing a program necessarily implies encoding the program. Further a structural/functional relationship exists

because the medium and the stored program cause the computer to execute method steps. To summarize, claims 10 and 11 are statutory, without amendment, under the guidance laid out by the Examiner.

Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §101.

35 U.S.C. §112, 2nd Paragraph

Claims 1-11 stand rejected under §112 as being indefinite for failing to point out and distinctly claim the subject matter of the invention. Applicant respectfully traverses the rejections.

1. “such as” phrases

The Examiner objects to the language in claims 1, 4, and 7-11 on the grounds that the phrase “such as” renders the claim indefinite. The Examiner cites MPEP §2173.05(d) as providing guidance in this area, however Applicant respectfully disagrees with the Examiner’s application of this section.

There is a significant difference in the claim language of the instant set of claims, which recites performing various steps “in such a manner as to...” do some task, and the language typically following “such as” clauses. The MPEP’s prohibition against “such as” phrases is relevant in cases where lists are presented in order to demonstrate individual examples of a previously stated subject. For example, a claim might recite a “mixture comprising a liquid and an inert gas, such as argon, krypton and xenon.” This type of claim could be considered indefinite in that it is unclear whether the claim comprises all the inert gasses or just the three

listed. Applicant asserts that the language used in claims 1, 4, and 7-11 simply expresses the functionality of the action steps of the method, which are not indefinite.

Applicant concedes that the language in question might be considered an idiomatic expression (objected to by the Examiner in paragraph 7 of the Office Action) and as such, claims 1, 4, and 7-11 have been amended to further clarify the claims and advance prosecution.

2. use of the term “outside”

The Examiner has pointed out instances in the claims where use of the term “outside” is used in a manner that might be considered unclear. Applicant has amended claims 4, 6-7, 9, and 11 to further clarify the claims and advance prosecution.

3. other idiomatic expressions

The Examiner has objected to the claims as containing idiomatic and grammatical errors. In this regard, Applicant has reviewed the claims, and made amendments where it appears that editing would further clarify a claim.

Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §112(2).

35 U.S.C. §112 1st Paragraph

Claims 1 stands rejected under §112 as not being enabled under §112 as it relates to “generating detection information.” Applicant respectfully traverses the rejections.

The Examiner argues that Applicant does not enable a person skilled in the art to make and use the invention commensurate in scope with the claims. With all due respect, Applicant suggests that the Examiner has failed to meet the initial burden of establishing a reasonable basis

to question the enablement provided in the claimed invention. See MPEP §2164.04. That section states:

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.... According to In re Bowen, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. (underlining added for emphasis)

The Examiner has not provided any reasonable explanation as to why the scope of protection in the claims is not adequately enabled. To the contrary, the Examiner makes a simple, stark assertion of lack of enablement, without substantive comment.

Claim 1, step (ii) recites “generating detection information...” Applicant asserts that claim 1 is adequately enabled, and would direct the Examiner to a few portions of the drawings and specification demonstrating the same. Please see:

1. Figure 2, item 12, demonstrating an apparatus for implementing the detection step.
2. Figure 6, item S30, demonstrating the step of detecting wireless communication terminals
3. Specification p. 23, lines 8-16

These non-limiting examples provide support that the claims are enabled, but are not meant to be an exhaustive list. There are other examples throughout the specification and drawings.

Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §112(1).

Drawings

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a). Applicant respectfully traverses the objection, and request withdrawal of the objection. Initially, as to the limitation reciting, “to reduce a total number of nodes operating in the master node,” Applicant would direct the Examiner to Figure 5, items S23 and Figure 7, item S41. These items demonstrate determining a solution for reducing the number of master nodes in the network. Additional drawings demonstrate carrying out the communication and switching of nodes to implement the solution of reducing the number of master nodes. Applicant asserts that the drawings adequately show this feature of the claims.

The remaining limitations that the Examiner cites are taken from claims 4 and 5, relating to nodes. The specification points out that a node is a generic term indicating a device with communication facility, such as servers and terminal devices. See Applicant’s specification, page 7, lines 6-8. Figure 2 clearly labels item 10 as a terminal and further depicts items 11-15 as the units that comprise the means recited in claims 4 and 5. That is to say, the components of the terminal act as master selecting means, construction means, first searching means, second searching means, repeating means, and determining means. Please note that the Examiner indicates that the claims recite “second first searching means” but this phrase does not appear in the claims. Applicant respectfully requests withdrawal of the objection to the drawings.

Allowable subject matter

Applicant appreciates the Examiner’s indication of allowable subject matter, and would like to present a few remarks related to the discussion presented by the Examiner.

The Examiner initially states that, with respect to claims 1 and 10, the “Admitted Prior Art (APA) is the closest prior art to the application invention...” The Examiner does not expressly cite what he deems to be the closest prior art at that section of the Action. Rather, the examiner provides an overview of the current application, and parenthetically points to pages 13-14 of the current specification to support his description. Applicant respectfully notes that those portions of Applicant’s specification cited by the Examiner do not bear upon the scope of protected subject matter. The invention is defined by all of the allowed claims, which stand upon their own recitations, and limitations should not be imputed to any of the claims based upon the Examiner’s summarization of the invention or any statements in the Reasons for Allowance. Applicant additionally notes that while the Examiner appears to cite Tanada, U.S. Patent Application Publication 2003/124979 (now U.S. Patent 7,164,887) as the closest prior art, Applicant has never deemed this reference to be admitted prior art. By including this reference in an Information Disclosure Statement (IDS), filed May 16, 2006, Applicant has only acknowledged that Tanada is “material to patentability.” See MPEP §609 and 37 CFR 1.51.

The Examiner has affirmatively stated that claims 4, 7-9, and 11 are allowable over the prior art. The Examiner also has indicated allowability of the network configuration method recited in claim 1. Applicant asserts that the corresponding computer implemented network reconfiguration program and computer-readable medium, recited in claims 8 and 10 respectively, are allowable as well. In addition, Applicant asserts that dependent claims 2-3 and 5-6 are additionally allowable at least because their underlying independent claims contain allowable subject matter.

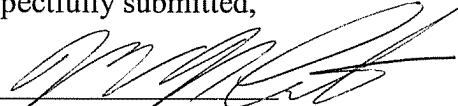
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact James M. Alpert (Reg. No. 59,926) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: **June 20, 2007**

Respectfully submitted,

By 

Michael R. Cammarata

Registration No.: 39,491

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant


MRC/JMA/vd/cm